17.   (Once Amended) The method of claim 13, further comprising displaying a graphical user interface having a selection indicator for each of the data types.

REMARKS

Upon entry of this Response, claims 1-3, 5-9, 11-15 and 17-18 remain pending in the present application. Claims 7 and 13-15, and 17 have been amended. Applicant respectfully requests reconsideration of the pending claims in light of the following remarks.

With respect to items 5 and 6, the Office Action notes that certain limitations in claims 7-9, 11-12, 13-15, and 17-18 lack antecedent basis. Claims 7 and 13 have been amended so as to provide for proper antecedent basis of all elements. In addition, claims 14, 15, and 17 have been amended herein so as to accord with amendments to claim 13. Accordingly, Applicant respectfully requests that the objection to claims 7-9, 11-12, 13-15, and 17-18 be withdrawn.

In item 8 of the Office Action, claims 1-2, 5-8, 11-14, and 17-18 have been rejected under 35 U.S.C. §102(e) as being anticipated by US Patent 5,999,664 issued to Mahoney et al. ("Mahoney"). It is axiomatic that anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction." WL Gore and Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). Applicant respectfully asserts that Mahoney fails to teach all the limitations of claim 1.

Specifically, claim 1 recites

"a user interface that displays the digital document, wherein *only ones of the regions that comprise one of the predefined data types selected in the selection interface appear in the displayed version* of the digital document." (emphasis added)

Applicant asserts that at least this feature is not shown or suggested in Mahoney. Specifically, Mahoney discloses a document search system that provides for "progressive transmission" of layout objects to be displayed on a display device. The Office Action states:

"Furthermore, Mahoney teaches a user interface for displaying only the selected document region including features selected by the user

interface for identifying set of features of search and further processing (col. 33, line 57-col. 34, lines 1-67, fig. 6, 9-10, 12-14)."

Applicant respectfully disagrees. In neither the above cited portions of Mahoney, nor anywhere else does Mahoney disclose displaying only the selected regions as claimed by Applicant. Rather, Mahoney discusses the display of all regions in one manner or another. Consequently, Applicant asserts that the rejection of claim 1 is improper. Additionally, claims 7 and 13 recite features similar in scope to claim 1. Accordingly, Applicant asserts that the rejection of claims 7 and 13 are improper for the same reasons discussed above with respect to claim 1. Also, Applicant asserts that the rejection of claims 2, 5-6, 8, 11, 12, 14, and 17-18 is improper as these claims depend from claims 1, 7, and 13, respectively. Therefore, Applicant respectfully requests that the rejection of claims 1-2, 5-8, 11-14, and 17-18 be withdrawn.

In addition, in item 10 of the Office Action, claims 3, 9, and 15 have been rejected under 35 USC §103(a) as being unpatentable over Mahoney in view of US patent 5,995,996 issued to Venable ("Venable"). It has long been accepted that prima facie case of obviousness established only when the teachings from the prior art itself appear to have shown or suggested the claimed subject matter to a person of ordinary skill in the art. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Applicant asserts that Venable fails to show or suggest the limitations that are also not shown or suggested by Mahoney as described above. Specifically, the cited combination of references fails to show or suggest all of the limitations in claims 3, 9 and 15 for at least the same reasons discussed above with reference to claims 1, 7 and 13 from which claims 3, 9 and 15 depend, respectively. Accordingly, Applicant respectfully requests that the rejection of claims 3, 9 and 15 be withdrawn.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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APPENDIX

Below are the Amended portions of the present application with appropriate markings that illustrate the changes made herein. All added text is noted by underlining and all deleted text is noted by strikethrough (i.e. ~~example~~).

IN THE CLAIMS:

7.   (Twice Amended) A system for controlling document region analysis, comprising:

analyzing means for analyzing a digital document to determine a number of regions thereon and a data type for each of the regions, the data type for each region being one of a number of predefined data types;

selection means for selecting at least one of the predefined data types for further processing; and

user interface means for displaying the digital document, wherein only ones of the regions that comprise one of the predefined data types selected <u>using</u> ~~in~~ the selection <u>means</u> ~~interface~~ appear in the displayed digital document.

13.   (Twice Amended) A method for controlling document region analysis, comprising ~~the steps of~~:

analyzing a digital document to determine a number of regions thereon and a data type for each of the regions, the data type for each region being one of a number of predefined data types;

selecting at least one of the predefined data types for further processing; and

displaying the digital document in a user interface, wherein only ones of the regions that comprise <u>a selected at least</u> one of the predefined data types ~~selected in the selection interface~~ appear in the digital document displayed in the user interface.

14.   (Once Amended) The method of claim 13, ~~wherein the step of identifying at least one of the predefined data types~~ further <u>comprising</u> ~~comprises the step of selecting and~~ deselecting <u>at least one of</u> ~~each~~ the predefined data types.

15.   (Once Amended) The method of claim 13, further comprising ~~the step of~~ identifying at least one processing pipeline to process the regions of the digital document based upon a predetermined destination application and the data types <u>selected</u> ~~identified~~ for further processing.

17.   (Once Amended) The method of claim 13, further comprising ~~the step of~~ displaying a graphical user interface having a selection indicator for each of the data types.